

REMARKS

Claims 207-236 are pending in the present application.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. The Rejection of Claim 222-236 under 35 U.S.C. § 102

Claims 222-236 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kundu *et al.* (*Applied Microbiology*, April 1970, p. 598-603). The Office Action states:

Applicant's claims are drawn to a method of producing the secreted polypeptide of claim 207 comprising cultivating a microbial strain, which in its wild-type form produces the polypeptide in a medium under conditions suitable for production of the polypeptide; and recovering the polypeptide from the medium. It is noted that the peptide of claim 207 is in isolated form. As defined in the specification at p. 9, lines 6-7 isolated form is essentially free of other non-aminopeptidase polypeptides. Yet the method as defined in claim 222 fails to delineate those method steps which would result in the claimed peptides isolation free of other non-aminopeptidase polypeptides. Even though the claim references the peptide of claim 207 the peptide as claimed in claim 222 is not noted to be in isolated form and no steps provide for it in the absence of other non-aminopeptidase polypeptides. Thus, the Examiner may rely on inherency in that the *Aspergillus oryzae* culture would be expected to produce the peptide of claim 207 in its natural form as the strain is the preferred of Applicant's invention and is in its wild-type capable of producing the peptide when cultured as noted. Kundu provides the isolated medium via the isolation of cultured protein isolates from submerged fermentation broth. The courts have settled that a product inherently possesses all characteristics of that product (see, e.g., *Ex parte Gray*, 10 USPQ2d, 1922; *In re Best*, 195 USPQ 430), and that "the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Further, it is well noted that process limitations cannot distinguish a claimed product. Accordingly, since the issue is whether the protein preparation of the prior art from *Aspergillus oryzae* is patently indistinct from that of the claimed material, Appellants have the burden of showing that inherency is not involved". *Ex parte Gray*, 10 USPQ 2d 1922 (1989); *In re Best*, 195 USPQ 430 (CCPA 1976). While the peptide of claim 207 is "isolated" the peptide produced via the claimed method and in composition is not so isolated and thus the prior art reference to the method of isolation and composition are sufficient to meet all limitations of the claimed invention.

This rejection is respectfully traversed.

Under the standard required for anticipation under 35 U.S.C. § 102, claims are properly rejectable as being anticipated under 35 U.S.C. § 102, even though all the limitations recited therein are not explicitly mentioned in the prior art reference, provided any limitation not expressed is inherent. *In re Sovish*, 227 USPQ 771, 774 (CAFC 1985). However, in order for something to be "inherent" in a disclosure, it must be the necessary and only reasonable construction to be given to the disclosure, that is, the result claimed must inevitably occur. *Light v. Hauss*, 199 USPQ 587, 589 (Bd. Pat. Int. 1978).

Kundu *et al.* disclose the production of amylase in liquid culture by a strain of *Aspergillus oryzae*. However, Kundu *et al.* do not disclose the production and isolation of a secreted polypeptide having aminopeptidase activity, as claimed herein. The Examiner relies on

inherency in that the *Aspergillus oryzae* culture of Kundu *et al.* would be expected to produce the peptide of claim 207 in its natural form as the strain is the preferred of Applicant's invention and is in its wild-type capable of producing the peptide when cultured as noted. However, in order for something to be "inherent" in a disclosure, it must be the necessary and only reasonable construction to be given to the disclosure, that is, the result claimed must inevitably occur. Under this standard, every microorganism, including every *Aspergillus oryzae*, when cultivated in its wild-type form must produce the polypeptide having aminopeptidase activity as claimed herein. Kundu *et al.* do not disclose the production and isolation of a secreted polypeptide having aminopeptidase activity, as claimed herein.

Applicants also respectfully note that when a claim depends on another claim, all of the limitations of the other claim are incorporated into the dependent claim. Since claims 222 and 223 depend on claim 207, the limitation of claim 207 which recites "An isolated secreted polypeptide having aminopeptidase activity ..." is incorporated into claims 222 and 223 (and dependent claims thereof. Consequently, the limitation of "an isolated secreted polypeptide having aminopeptidase activity" is automatically incorporated into the dependent claims of 222 and 223. However, to further prosecution, claims 222 and 223 have been amended to recite "the isolated secreted polypeptide of claim 207."

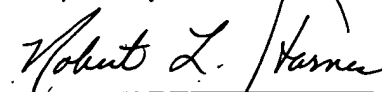
For the foregoing reason, Applicants submit that this rejection under 35 U.S.C. § 102 has been overcome. Applicants respectfully request reconsideration and withdrawal of the rejection.

II. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

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Respectfully submitted,



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